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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/687,144	10/13/00	DOMENICO P	P/2526-22 (R

HM22/0213
OSTROLENK FABER GERB & SOFFEN LLP
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EXAMINER	
SPIVACK,P	
ART UNIT	**PAPER NUMBER**
1614	4

DATE MAILED: 02/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/687,144	Applicant(s) Domenico
	Examiner Phyllis G. Spivack	Group Art Unit 1614

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1, 2, and 4-18* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1, 2, and 4-18* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *3*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The present application is a reissue of U. S. Patent No. 5,928,671 issued July 27, 1999. Claim 3 is canceled. Claims 1, 2 and 4-18 are under consideration.

The following papers filed October 13, 2000 are acknowledged: a Declaration/ Power of Attorney, an order for title report in accordance with 37 CFR 1.171, an assent of Assignee pursuant to 37 CFR 1.172, a certification of assignee pursuant to 37 CFR 3.73(b) and the original patent. The title report is actually not needed and in lieu of the 3.73 statement will not be considered . An Information Disclosure Statement filed October 13, 2000, Paper No. 3, is further acknowledged and has been reviewed.

The reissue declaration filed with this application is defective because it fails to describe the actual errors (i.e., the words or phrases) in the patent. It fails to specify distinctly the "excess" in the claims. 37 CFR 1.175(a)(3). See MPEP 1414. Applicant must point out every actual error in the patent.

Claims 1, 2 and 4-18 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedheim, GB 712,828.

Friedheim teaches therapeutically active compositions comprising compounds wherein a

bismuth-containing salt is complexed to a dimercapto compound. The claims differ in the ratio of the bismuth salt to the dithiol. However, in view of the teachings of Friedheim, one skilled in the art of formulation chemistry would have sought an optimal ratio of the two ingredients to obtain a therapeutically effective composition. Such would have been obvious in the absence of evidence to the contrary because the skilled artisan would have reasonably sought the most efficacious proportions in order to achieve a stable preparation and a therapeutic endpoint. The intended use of the composition confers no patentable weight to the claims.

Powell, P., J. Chem. Soc., is cited to show further the state of the art.

Any inquiry concerning this communication should be directed to Phyllis Spivack at telephone number (703) 308-4703.

February 11, 2001

Phyllis Spivack

PHYLLIS SPIVACK
PRIMARY EXAMINER